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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,252	02/03/2004	David Light	TESSERA 3.0-313	2593
38091	7590	04/25/2006	EXAMINER	
TESSERA LERNER DAVID et al. 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			AHMED, SHAMIM	
			ART UNIT	PAPER NUMBER
			1765	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/771,252

Applicant(s)

LIGHT ET AL.

Examiner

Shamim Ahmed

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I (claims 1-12) in the reply filed on 2/21/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 5-6, 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding claim 5, the phrase "providing a first mask " renders the claim indefinite because it is unclear whether the "first mask" is referring the mask in claim 1 or a different mask.
5. Claim 9 recites the limitation "the step of removing said first mask" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 4 –6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida (JP-03251395).

Assuming the first mask in claim 5 is same as the mask in claim 1, Yoshida teaches forming a metal mold including the step of forming a masking material layer of photoresist layer (2) on a base metal substrate (1), wherein the mask layer is selectively exposed to form openings in the mask layer in order to form mask pattern and etching the metal plate of metal substrate to form recess in the metal plate by etching through the mask pattern.

It is shown that the removing the material of the base is aligned with the mask openings (See, figure C and see the abstract, constitution).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (JP-03251395) as applied to claims 1-2,4-6 above, and further in view of Otsuki et al (5,633,529).

Yoshida teaches above in the paragraph 7 but fails to teach the etching of the metal base layer is performed with ferric chloride.

However, Otsuki et al teaches ferric chloride is used to etch a metal layer to form metal mold (figures 15-15B).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of claimed invention to employ Otsuki et al's teaching into Yoshida's process for effective etching of the metal (stainless steel) as taught by Otsuki et al.

As to claim 9-12, Yoshida teach the mask pattern is formed by selective light exposure through a necessary mask (abstract).

Therefore, curing the masking material is an obvious step in the photolithographic process.

11. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (JP-03251395) as applied to claims 1-2,4-6 above, and further in view of Dufresne et al (6,537,459).

Yoshida teaches above in the paragraph 7 but fails to teach the photoresist masking layer is formed by electrophoretic deposition process.

However, in a method of etching selectively a metal base material using photoresist masking layer, Dufresne et al teach that photoresist is deposited on a metal substrate using conventional processes including spray coating, electrophoretic coating etc., preferably by electrophoretic deposition process (col.8, lines 8-15).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of claimed invention to employ Dufresne et al's teaching into Yoshida's process for selectively etching the metal substrate with accuracy as taught by Dufresne et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shamim Ahmed whose telephone number is (571) 272-1457. The examiner can normally be reached on M-Thu (7:00-5:30) Every Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine G. Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shamim Ahmed  
Primary Examiner  
Art Unit 1765

SA  
April 22, 2006